



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/862,798	05/22/2001	Tammy L. Moser	A180 1010	1167

7590 05/03/2004

WOMBLE CARLYLE SANDRIDGE & RICE, PLLC
P.O. Box 7037
Atlanta, GA 30357-0037

EXAMINER

HUFF, SHEELA JITENDRA

ART UNIT	PAPER NUMBER
----------	--------------

1642

DATE MAILED: 05/03/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.		Applicant(s)	
	09/862,798		MOSER ET AL.	
	Examiner		Art Unit	
	Sheela J Huff		1642	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-52 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☐ Claim(s) ____ is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☒ Claim(s) 1-52 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date ____. | 6) <input type="checkbox"/> Other: ____. |

DETAILED ACTION

Election/Restrictions

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-2, 4-7, 9, 11-12, 14-17, 19, 20-22, 24-27, 29-30, 48-52 (as all these claims read on antibodies and fragments thereof), drawn to antibodies, compositions containing antibodies and methods of use, classified in class 424, subclass 133.1+.
- II. Claims 1-2, 7, 9, 11-12, 17, 19-20, 21-22 and 29-30 (as all these claims read on peptides/enzymes), drawn to compositions containing peptides/enzymes and methods of use, classified in class 514, subclass 12.
- III. Claims 1-2, 7, 9, 11-12, 17, 19-20, 21-22 and 29-30 (as all these claims read on oligonucleotides), drawn to compositions containing oligonucleotides and methods of use, classified in class 514, subclass 44.
- IV. Claims 1, 3, 7-8, 11, 13, 17-21, 23, 28-30 (as all these claims read on conjugate comprising anti-tumor agent that does not bind to the alpha or beta subunits of F1 ATP synthase and a compound that does bind to said synthase), drawn to compositions containing said conjugate and methods of use, classified in class 424, subclass 178.1+.
- V. Claims 31-44, drawn to method of screening for a test compound and the test compound, classified in class 435, subclass 7.21+.

Art Unit: 1642

- VI. Claims 45-47, drawn to expression construct, host cell and method of making protein using said host cell, classified in class 435, subclass 320.1+.

The inventions are distinct, each from the other because of the following reasons:

Inventions I-V and VI are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions are different because inventions I-IV require different products. For example, the product of invention I is an antibody or fragment thereof, which is patentably distinct from peptides/enzymes or oligonucleotides because antibodies have distinct chemical structures and functions as compared to peptides/enzymes or oligonucleotides. Additionally the method of invention V is a screening method which has different steps and end results from the methods of inventions I-IV. Invention VI is directed to the nucleic acid sequence encoding the alpha or beta subunits of ATP synthase whereas the products of the invention I-IV are not. The product of invention VI is chemically and structurally distinct from the products of the other inventions because nucleic acid sequences can be used in hybridizations assays whereas the products of the other groups cannot.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

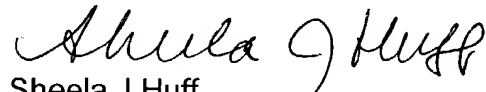
Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sheela J Huff whose telephone number is 571-272-0834. The examiner can normally be reached on Tuesday 5:30am-11:30am and Fridays 6:00am-4:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Yvonne Eyler can be reached on 571-272-0871. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Art Unit: 1642

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Sheela J Huff
Primary Examiner
Art Unit 1642

sjh